

Application No. 10/589,458  
AMENDMENT dated April 13, 2011  
Reply to Office Action of December 13, 2010  
Attorney Docket 1410-67688-US

#### REMARKS

Claims 1-56 are currently pending in the application. Claims 41-56 are withdrawn from further consideration per Applicants' response to the previous restriction requirement. Claims 1-40 stand rejected on the ground of nonstatutory double patenting. Claims 18-40 stand rejected under 35 U.S.C. § 112. Claims 1-24 stand rejected under 35 U.S.C. § 103(a). Applicants thank the Examiner for the indication that claims 25-40 are allowed. Therefore, claims 1-40 are pending and at issue. Applicants respectfully request reconsideration of the claims of this application in light of the remarks presented herein.

#### *Double Patenting*

Claims 1-40 stand provisionally rejected on the ground of nonstatutory double patenting over claims 1-35 and 52-67 of copending Application No. 10/589,459. As this is a provisional rejection, this rejection will be addressed should the claims be allowed.

Claims 1-40 stand rejected on the ground of nonstatutory double patenting over claims 1-31 of U.S. Patent No. 7,673,558. A terminal disclaimer is filed herewith to obviate this nonstatutory double patenting rejection.

#### *Claim Rejections Under 35 U.S.C. § 112*

Claims 18-40 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 19-40 stand rejected since they are dependent on claim 18.

Claim 18 is rejected as indefinite for the use of the term "sufficient" in the phrase "sufficient force" as recited in claim 18. Applicants assert that the scope of the term "sufficient force" is reasonably ascertainable to one of ordinary skill in the art based on the disclosure of the specification. Applicants assert that support for this phrase can be found at least at page 31, line 24 to page 33, line 24 of the Specification as filed.

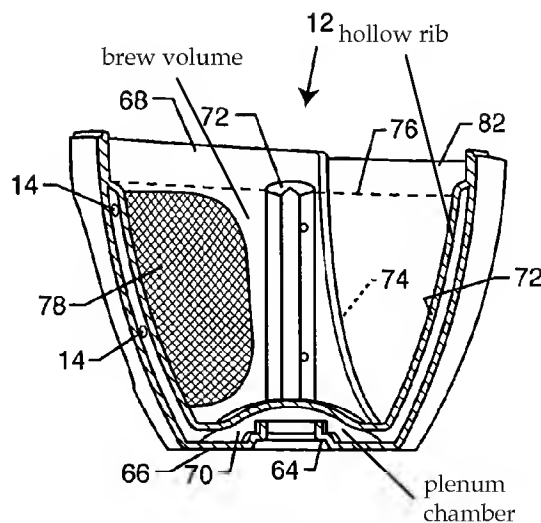
For at least the above reasons, Applicants assert that claims 18-40 are not indefinite under 35 U.S.C. § 112.

***Claim Rejections Under 35 U.S.C. § 103***

Claims 1-3 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,634,281 to Burrows<sup>1</sup>, and in view of U.S. Patent 7,032,503 to Cai (hereinafter "Cai '503").

With regard to claim 1, the applied references fail to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head "such that, in use, water from the inlet of the brew head passes upwardly through the inlet of the insert into the brewing volume and such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert" as recited in claim 1. The Office action alleges that this element is disclosed in Burrows. It is not. Accordingly, the proposed combination will not result in the claimed insert.

The water of Burrows does not flow upwardly into the brew volume. Instead, Burrows discloses that the inlet to the inner portion of the brew basket 12 be provided in the form of hollow ribs 72 formed in the brew basket side walls 68. An annotated version of Figure 10 of Burrows is provided to the right. Water flowing upwardly into a plenum chamber 70



**FIG. 10**

<sup>1</sup> It is noted that the U.S. patent number provided refers to a "Rotisserie Attachable Skewer Assembly" to Paul G. Conigliaro, and not to Burrows. For the purpose of responding to this Office Action, the Applicants refer to U.S. Patent No. 6,968,775 to Burrows et al. (hereinafter "Burrows") as applied in the prior Office Action dated June 28, 2010.

positioned below and separate from the brew volume of the basket 12. These hollow ribs 72 are disclosed as having closed upper ends and being provided with multiple jet ports 14 “positioned and aimed for jetting water streams generally tangentially in a common swirling direction...into the brew basket interior” (Burrows, Col. 5, lines 44-64). Such an arrangement is provided to generate centrifugal action against the brew basket side wall. (Burrows, Col. 6, lines 54-57). Therefore, instead of the water being introduced from the bottom of the brew volume upwardly into the brew chamber through an inlet formed in the bottom of the insert, as claimed, the water is introduced at various levels along the sidewall and above the bottom of the brew basket in Burrows.

The plenum chamber 70 is not the brewing volume containing the beverage ingredients, as claimed. Rather, the plenum chamber 70 is upstream of the interior of the brew basket containing ground coffee and is for distributing water to at least one of the hollow ribs 72 formed in the side wall of Burrows’ brew basket 12. (Burrows, Col. 5, lines 49-54). Supplying water into the plenum chamber 70 is different from water passing upwardly into the brewing volume, as claimed. Further, Burrows describes at Col. 5, lines 54-64 the arrangement of the ribs 72 and how in use this arrangement provides a tangential flow of water creating a swirling of the contents during brewing.

As each of the ribs 72 is described having “a closed upper end,” water exiting the ribs 72 does not describe the water passing upwardly into the brew volume. Instead, Burrows describes the water entering the brew basket 12 as being aimed tangentially to create a swirling motion of the water and coffee grounds and that this swirling motion is important in the brewing process of Burrows (Burrows, Col. 6, lines 14-25).

Cai does not cure the failing of Burrows. Similar to Burrows, Cai discloses that water is to be introduced from above the bottom of the insert. Particularly, Cai discloses that water is introduced from a brew head 35 downwardly into a brew basket 32 through a hygiene device 10. (Cai, Col. 2, line 54 – Col. 3, line 4). Because neither reference discloses or suggests an insert such that “water from the inlet of the brew head passes upwardly through the inlet of the inert

into the brew volume” as recited in claim 1, their proposed combination will not result in the insert of claim 1.

Therefore, the proposed combination of Burrows and Cai does not result in the claimed subject matter requiring that the water from the inlet of the brew head passes upwardly through the inlet of the insert into the brewing volume.

With further regard to claim 1, the applied references fail to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head “such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert” as recited in claim 1. The Office action alleges that this element is disclosed in Burrows. It is not. Accordingly, the proposed combination will not result in the claimed insert.

Burrows discloses that its brew basket 12 is to be provided with brew basket side walls 68, “a portion of which is defined by one or more mesh or mesh-like filter elements 78. Such filter elements 78 are supported by the brew basket 12 in slightly spaced relation to the adjacent divider wall 36 to define a flow pathway” (Burrows, Col. 6, lines 55-59). The filter elements 78 are provided in the side wall 68 of the brew basket 12, such that the flow is radially outward from the brew basket (*see* Burrows, Col. 2, lines 46-53). Based on this description, fluid flow is radially outward through the filter 78 and not downward. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01. Due to the positioning of the plenum chamber 70, modification of Burrows would not allow the positioning of a downwardly oriented outlet. Therefore, Burrows does not disclose or suggest a “beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert” as presently claimed, and modification to include a downwardly oriented outlet would modify Burrows unsatisfactorily for its intended purpose.

Application No. 10/589,458  
AMENDMENT dated April 13, 2011  
Reply to Office Action of December 13, 2010  
Attorney Docket 1410-67688-US

For at least the above discussed reasons, it is asserted that the applied references fail to disclose or suggest claim 1 and thereby Applicants respectfully request reconsideration and allowance of claim 1.

Claims 4-13, 18-20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burrows, and in view of Cai '503, and further in view of U.S. Patent 6,777,007 to Cai (hereinafter "Cai '007"). Claims 21 and 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burrows, and in view of Cai '503, and further in view of Cai '007, and in view of U.S. Patent Publication 2004/0197444 to Halliday et al. (hereinafter "Halliday").

With regard to claims 4-9, the applied references do not describe or suggest loading a container containing the beverage ingredients and comprising filtering means into the receptacle. Burrows states that the function of his brew basket is to "stir and agitate the combined body of coffee grounds and water to suspend and swirl the coffee grounds in the form of a water-borne fluidized suspension." (Burrows, Col. 6, lines 18-20). Cai '503 and Cai '007 are applied by the Office Action as describing containers comprising filtering means.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01. To modify operation of Burrows by using a container with a filter in the brew basket 12 would interrupt the function of the brew basket and modify the brew basket 12 unsatisfactory for its intended purpose. As such, placing coffee grounds in a container comprising filtering means and then placing the container into the brew basket 12 would interrupt the function of Burrows' brew basket 12 and modify it unsatisfactory for its intended purpose. Additionally, the brew basket of Burrows functions as both a container and a filter. As such, the Office Action provides no reason for duplicating the containment and filtering functions of the brew basket. Thus, there is no motivation for the proposed modification with respect to claims 4-9.

Application No. 10/589,458  
AMENDMENT dated April 13, 2011  
Reply to Office Action of December 13, 2010  
Attorney Docket 1410-67688-US

In view of the above discussion of claim 1, it is respectfully asserted that claims 2-40 dependent therefrom are allowable as well.

*Conclusion*

For all of the reasons mentioned above, the Applicants respectfully request reconsideration and allowance of all pending claims. The Examiner is invited to contact the undersigned attorney to expedite prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,  
FITCH, EVEN, TABIN & FLANNERY

Dated: April 13, 2011

/Eric D. Misfeldt/  
Eric D. Misfeldt  
Registration No. 59,527  
[emisfeldt@fitcheven.com](mailto:emisfeldt@fitcheven.com)

120 South LaSalle Street, Suite 1600  
Chicago, Illinois 60603-3406  
Telephone (312) 577-7000  
Facsimile (312) 577-7007  
583273

Appendix